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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,987	03/31/2000	Yasutoshi Shindo	31581-159316	3235
26694	7590	05/10/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			Caldwell, Andrew T	

ART UNIT PAPER NUMBER

2151

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/540,987	SHINDO, YASUTOSHI
	<b>Examiner</b> Andrew Caldwell	<b>Art Unit</b> 2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 February 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,8 and 9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 3-7 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

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## **Remarks**

Claims 1-9 are pending.

This application contains claims 3-7 drawn to an invention nonelected with  
use in Paper No. 4, filed on October 1, 2003. A complete reply to the final rejection  
include cancellation of nonelected claims or other appropriate action (37  
.144) See MPEP § 821.01.

## ***Specification***

The specification is objected to as failing to provide proper antecedent basis for claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction following is required: See the rejection under 35 U.S.C. 112 first paragraph

## ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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1 had possession of the claimed invention. The specification does not describe a  
2 resident application that runs continuously. As to whether the resident application runs  
3 continuously or is executed and halted as needed, the specification is silent.

4

5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

6 The specification shall conclude with one or more claims particularly pointing out and distinctly  
7 claiming the subject matter which the applicant regards as his invention.

8 Claims 1-2 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as  
9 being indefinite for failing to particularly point out and distinctly claim the subject matter  
10 which applicant regards as the invention.

12

13 As to claim 1, it was amended to include the limitation of using information saved  
14 upon execution of a transaction by the downloaded application when the application  
15 cannot be downloaded from the web server. It is unclear how a transaction can be  
16 executed by the downloaded application when the application cannot be downloaded.  
17 The fact that the downloaded application is executing means that the application must  
18 have been downloaded.

19 As to claims 2 and 8, they are dependent on claim 1 and are rejected for the  
20 same reasons as claim 1.

21 As to claim 9, it contains language similar to claim 1 and is rejected for the same  
22 reasons.

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## ***Response to Arguments***

2 Applicant's arguments, see paper no. 6, filed February 26, 2004, with respect to  
3 the rejection(s) of claim(s) 1-2 under 35 U.S.C. 103(a) have been fully considered and  
4 are persuasive. Therefore, the rejection has been withdrawn. In the remarks at the  
5 bottom of page 8 and the top of page 9 of the response, the Applicant distinguishes an  
6 application program and a system as in Drummond that implements a transaction using  
7 a browser to download a series of web pages including Java applets. The Applicant  
8 argues that since applets must be executed by another application (i.e. a browser), the  
9 system described by Drummond cannot teach a resident application. The implication  
10 being that the resident application is a stand alone program. While the Examiner  
11 agrees that the specification provides support for a stand alone resident application, the  
12 Examiner would point out that this statement and the claim amendments effectively  
13 exclude embodiments as per page 27 second complete paragraph of the Applicant's  
14 specification where the transaction system is provided only with contents that constitute  
15 screens of the automatic transaction apparatus from the web server. This statement  
16 describes a transaction system implemented using a series of web pages.

### **Conclusion**

19           Applicant's amendment necessitated the new ground(s) of rejection presented in  
20 this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP  
21 § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37  
22 CFR 1.136(a).

24 A shortened statutory period for reply to this final action is set to expire THREE  
25 MONTHS from the mailing date of this action. In the event a first reply is filed within  
26 TWO MONTHS of the mailing date of this final action and the advisory action is not

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1 mailed until after the end of the THREE-MONTH shortened statutory period, then the  
2 shortened statutory period will expire on the date the advisory action is mailed, and any  
3 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
4 the advisory action. In no event, however, will the statutory period for reply expire later  
5 than SIX MONTHS from the date of this final action.

6

7 Any inquiry concerning this communication or earlier communications from the  
8 examiner should be directed to Andrew Caldwell, whose telephone number is (703)  
9 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m.  
10 EST.

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12 If attempts to reach the examiner by phone fail, the examiner's supervisor,  
13 Glenton Burgess, can be reached at (703) 305-4792. Additionally, the fax numbers for  
14 Group 2100 are as follows:

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16 Fax Responses: (703) 872-9306

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18 Any inquiry of a general nature or relating to the status of this application should  
19 be directed to the Group receptionist at (703) 305-9600.

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26 Andrew Caldwell

27 703-306-3036

28 May 6, 2004

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